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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,735	07/21/2003	Yasuaki Tsuchiya	8017-1096	4719

466 7590 01/13/2006

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ARLINGTON, VA 22202

EXAMINER
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MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/622,735

**Applicant(s)**

TSUCHIYA ET AL.

**Examiner**

Michael A. Marcheschi

**Art Unit**

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/1/05, 9/12/05</u> | 6) <input type="checkbox"/> Other: _____  |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

In view of applicants submission of a certified translation of the priority document, the rejection relied upon (and thus the finality) in the previous office action is withdrawn. However, new art has been found and is applied in the following action. Since the amendments to the claims on 12/27/04, which inserted all of the features of original claims 2, 4 and 5, as well as, specific triazole components, were never originally claimed in combination, this new combination can warrant a final rejection based on new art because it is necessitated by applicants amendment. In view of this, the following action, although based on new art, is made final.

Claims 1, 3 and 6 are rejected under 35 U.S.C. 103 (a) as being obvious over Tsuchiya et al. (2002/0095872).

The applied reference teaches in the abstract and sections [0026]-[0030], [0044]-[0052] and examples 4-11, a polishing composition having the claimed pH comprises the colloidal silica, an oxidizer, an amino acid (glycine), a triazole component (claimed material used in the claimed amounts) and water. Examples 4-11 define a ratio for the amino acid/triazole (used in colloidal silica polishing compositions) which is within the claimed range.

The reference teaches a polishing composition having the claimed pH which meets the claimed invention because the composition comprises all of the claimed components in the claimed amounts. In addition, the reference teaches a ratio the amino acid/triazole which is within the claimed range. In view of this, the subject matter as a whole would have been obvious

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to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976). In addition, the above examples disclose all of the claimed features, except the pH. However, one skilled in the art would have appreciated and therefore found obvious that the pH of these examples should be consistent with what is disclosed in the specification (pH 4-8) absent evidence to the contrary.

Applicant's arguments with respect to claims 1, 3 and 6 have been considered but are moot in view of the new ground(s) of rejection.

**Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.** The amendments to the claims on 12/27/04, which inserted all of the features of original claims 2, 4 and 5, as well as, specific triazole components, were never originally claimed in combination, thus this new combination can warrant a final rejection based on new art.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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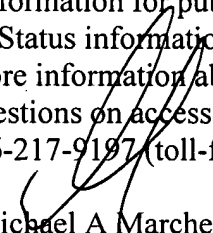
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/05  
MM

  
Michael A Marcheschi  
Primary Examiner  
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